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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
AND
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : Paul Bilibin, et al.
Application No. : 09/685,077
Filed : October 6, 2000
Title : Apparatus, Systems and Methods for Online,
Multi-Carrier, Multi-Service Parcel Shipping
Management Determination of Ratable Weight
for Multiple Carriers
Technology Ctr : 3600
Grp./Div. : 3629
Examiner : Jamisue A. Plucinski
Docket No. : PSTM0020/MRK

APPELLANT'S REPLY BRIEF TRANSMITTAL LETTER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
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February 7, 2007

Commissioner:

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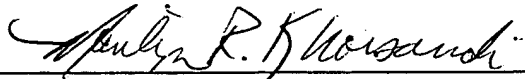
1. Appellant's Reply Brief (19 pages); and
2. Return post card.

It is respectfully submitted that the enclosed Appellant's Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of February 14, 2007, which is the last day of the two month period following the December 14, 2006 date of the Examiner's Answer.

Even so, the Commissioner is hereby authorized, pursuant to 37 CFR 1.136(a)(3), to treat any concurrent or future reply or correspondence for the above-identified application, requiring a petition for an extension of time for its timely submission, as incorporating a constructive petition for extension of time for the appropriate length of time. The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17, including any required extension fees, which may be

required during the **pendency** of this application, to Deposit Account No. 501574. Please show our docket number with any charge or credit to our Deposit Account. **A copy of this letter is enclosed.**

Respectfully submitted,
KHORSANDI PATENT LAW GROUP, ALC

By 
Marilyn R. Khorsandi
Reg. No. 45,744
Customer No. 29524
626/796-2856

MRK/aa
Enclosures



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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Application No. : 09/685,077
Filed : October 6, 2000
Title : APPARATUS, SYSTEMS AND METHODS FOR ONLINE,
MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING
MANAGEMENT DETERMINATION OF RATABLE WEIGHT
FOR MULTIPLE CARRIERS
Technology Center : 3600
Grp./Div. : 3629
Examiner : Plucinski, Jamisue A.
Docket No. : PSTM0020/MRK

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Pasadena, CA 91101-4710
February 7, 2007

APPELLANT'S REPLY BRIEF

This is a Reply to the Examiner's Answer, dated December 14, 2006, regarding the pending Appeal of the rejection of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 in the case of the above-identified application.

An Oral Hearing is not requested.

It is respectfully submitted that this Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of February 14, 2007, which is the ending date of the two month period following the December 14, 2006 date of the Examiner's Answer.

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REPLY ARGUMENT

For the reasons given and the authorities cited below and in the Appeal Brief, it is respectfully asserted that Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 are not anticipated by, and are non-obvious over, Nicholls, Kara, Barns-Slavin and Jensen, whether considered alone or in combination with any other reference(s) of record. Accordingly, it is respectfully requested that the rejections of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 be reversed, and that the Claims on appeal be allowed.

Reply Argument Regarding Issues 1a, 1b and 1c Regarding the Rejection of Claims 1-5, 58-59, 70 and 72 under 35 U.S.C. §102(b) as Being Anticipated by Nicholls: The Rejections Are Based on Impermissible Hindsight Using the Claimed Invention As a Roadmap to Pick and Choose Disparate Portions of Nicholls on Which to Base Anticipation

For the reasons given and the authorities cited below, it is respectfully asserted that the conclusions given in the Examiner's Answer regarding Appellant's Arguments regarding Issues 1a, 1b, and 1c are based on impermissible hindsight using the invention claimed in the present application as a roadmap to pick and choose disparate portions of the Nicholls reference and using what could be described as "common sense" arguments based on the disclosure and teachings of the present application, not based on any evidence in the prior art, to combine those portions to conclude anticipation of Claims 1-5, 58-59, 70 and 72. Cf., e.g., In re Mahurkar Patent Litigation, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995) (Opinion by Judge Easterbrook; "... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis. ... With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. 'Virtually all inventions are combinations and virtually all are combinations of old elements.' Unless the prior art *itself* suggests the particular combination, it does not show that the actual invention was obvious or anticipated.") (Citations omitted); cf. also, e.g., In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) ("With respect to core factual findings in a

determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

The Appeal Brief respectfully submitted that there is no disclosure in Nicholls that Nicholls calculates a dimensional weight, much less that it calculates a dimensional weight for *each carrier* of a plurality of carriers, or that it does so by applying a respective set of carrier-specific dimensional weight calculation rules.

In response to that position, the Examiner's Answer cites columns 21 and 22, line 65 of Nicholls, and states that “... the examiner considers this to be a dimensional weight calculation rule ...” Examiner's Answer Response to Appellant's Issue 1a Argument, p. 7.

It is respectfully asserted that the column 21 and 22 portions of Nicholls cited by the Examiner's Answer do not support the Examiner's Answer's assertion that Nicholls discloses a dimensional weight calculation rule. Specifically, the cited columns 21 and 22 of Nicholls list many entries in a "Table II" of Nicholls; the cited entry at line 65 in "Table II" is identified as an "I/O Token" named "DIMWT" and is described as "dimensional weight". Nicholls, cols. 21-22, line 65. Other than the listing of the "DIMWT" I/O Token in Table II of Nicholls, it is respectfully submitted that there is no further mention of the "DIMWT" I/O Token in Nicholls. Further, it is respectfully submitted that, other than a listing of a "DIMWT" I/O Token in Table II of Nicholls, and the description of that token as a "dimensional weight," there is no other mention of dimensional weight in Nicholls.

Even so, the Examiner's Answer cites Nicholls, col. 2, lines 17-19 and col. 4, lines 49-55 and Claim 1 as support for the proposition that the mere listing of an I/O token for "DIMWT" in a table of I/O tokens should be extended to indicate that Nicholls discloses a "dimensional weight calculation rule.”

It is respectfully asserted that the column 2 and column 4 portions of Nicholls cited by the Examiner's Answer do not support the Examiner's Answer's assertion that Nicholls discloses a dimensional weight calculation rule. The cited column 2 portion of Nicholls makes the general statement that:

...[T]here is one rate server for each carrier (e.g., U.S. Postal Service, Federal Express, United Parcel Service, etc.) and these servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier.

Nicholls, col. 2, lines 14-19. The cited column 4 portion of Nicholls makes the general statement that:

...[T]he presently preferred embodiment places carrier-related information, such as shipping rates, shipping rules, time in transit information and the like on one or more rate servers. These servers are responsible for making all determinations regarding how a given carrier's rules and rate structures are to be interpreted.

Nicholls, col. 4, lines 49-55.

Even though none of the above-quoted portions of Nicholls disclose a dimensional weight calculation rule, the Examiner's Answer urges that the above-general statements by Nicholls should be extended to encompass the claimed limitations of, e.g., Claim 1 to:

in response to the first input [comprising a first set of parcel specifications for a first parcel]... apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers, to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel ...

However, as respectfully asserted in the Appeal Brief, there is nothing inherent in the statement, e.g., "... these [rate] servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier..." (Nicholls, col. 2, lines 14-19), that the rate servers are necessarily programmed to include any particular detail of a shipping rate calculation such as a calculation of dimensional weight according to a carrier-specific dimensional weight calculation rule. Still further, as respectfully asserted in the Appeal Brief, the appearance of only a single "DIMWT" I/O Token entry in the Nicholls' Table II, is evidence that Nicholls does not disclose that the rate servers are programmed to include carrier-specific calculations of dimensional weight according to carrier-specific dimensional weight calculation rules.

Moreover, it is respectfully asserted that it would be erroneous to link the appearance of only a single "DIMWT" I/O Token entry in the Nicholls' Table II to the Nicholls statement that "... these [rate] servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier..." (Nicholls, col. 2, lines 14-19), and to conclude on that basis that the two linked portions of Nicholls disclose the above-cited claimed limitations of, e.g., Claim 1. Cf., e.g., Brown v. 3M, 265 F.3d 1349, 1351, 60 U.S.P.Q.2d (BNA) 1375, 1376 (Fed. Cir. 2001) ("To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim."); cf. also, e.g., Ecolchem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 1369-70, 56 U.S.P.Q.2d 1065, 1070-71 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 974 (2001) (holding that a district court improperly linked two portions of a reference to conclude anticipation; more specifically, holding that the district court erred in finding anticipation by a single reference of claims directed to a two-step deoxygenation process comprising a first step of contacting a liquid containing dissolved oxygen and hydrazine with bed of activated carbon to catalyze a reaction, followed by a second step of passing the liquid through [a "mixed bed" of] contaminant-removing resins; the district court erred by misconstruing a relationship between a figure in the reference showing a deoxygenation process using hydrogen followed by a "mixed bed", with a separate textual description of deoxygenation alternatives that included hydrazine.).

"Whether a claim limitation is inherent in a prior art reference is a question of fact." Telemac Cellular Corp. v. Topp Telecom, Inc., 247 F.3d 1316, 1328, 58 U.S.P.Q.2d (BNA) 1545, 1552 (Fed. Cir. 2001). If a feature is not explicitly disclosed by a reference, extrinsic evidence may be used to show inherency; the extrinsic "... evidence must make clear[, however,] that the missing feature is necessarily present and that it would be so recognized by persons of ordinary skill in the art." Telemac, 247 F.3d at 1328, 58 U.S.P.Q.2d at 1553 (relying on extrinsic evidence in holding as inherent, particular components (each of four call categories of local, long distance, international, and roaming) of a data structure (a "Call Detail Record")). It is respectfully asserted that neither the Office Action nor the Examiner's Answer cites any extrinsic evidence to support the propriety of linking the single I/O token for "DIMWT" in a table of

I/O tokens with the general statement by Nicholls that "... these [rate] servers are provided with a complete knowledge base of all rate structure data and shipping rules and regulations pertaining to that carrier..." (Nicholls, col. 2, lines 14-19) to conclude that the two linked portions of Nicholls disclose the above-cited claimed limitations of, e.g., Claim 1.

Moreover, the Examiner's Answer further posits that, because "... Nicholls discloses each carrier having a set of shipping requirements and predetermined rate structures ..." (citing Nicholls, col. 2, lines 17-19 and col. 4, lines 49-55 and Claim 1), that the mere listing of a single I/O token for "DIMWT" in a table of I/O tokens should be extended to indicate a disclosure by Nicholls of "... apply[ing] a respective set of carrier-specific dimensional weight calculation rules [in response to a first input comprising a first set of parcel specifications for a first parcel], for each respective carrier of a plurality of carriers, to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight ..." as claimed, for example, by Claim 1 of the present application. Examiner's Answer Response to Appellant's Issue 1a Argument, pgs. 7-8.

Notably, neither the Office Action nor the Examiner's Answer offers any explanation as to how a single "DIMWT" I/O token entry could be used by all of the rate servers for all of the carriers to calculate a billable weight and/or a rate, if, as the Examiner's Answer argues, each rate server is used to calculate or determine a dimensional weight according to each carrier's rules and is also used to calculate a rate for each carrier according to each carrier's rules according to each carrier's dimensional weight calculation.

Rather, as respectfully submitted in the Appeal Brief, other entries in Table II of Nicholls, such as, for example, the I/O Token entry labeled "TRACKNBR" following the "DIMWT" entry (described as "tracking number/COD tracking"), and the I/O Token entry named "CODRETTTRK" that follows the "TRACKNBR" entry (described as "COD return tracking number"), indicate *post-shipment-ordering*, and possibly carrier-supplied, fields, not pre-shipment-order calculations or determinations provided in response to an input of parcel specifications.

In response to that assertion, the Examiner's Answer argues that "Nicholls discloses the use of rate servers for each carrier, therefore each rate server is used for

a different carrier, and each rate is calculated according to that carrier.” Examiner’s Answer Response to Appellant’s Issue 1a Argument, p. 8. The Examiner’s Answer further argues that “[t]he rate cannot be calculated without first knowing the parcel specifications, therefore the table cannot be populated without first obtaining the parcel specifications and the table would be populated in response to a user entering in the parcel specifications.” Examiner’s Answer Response to Appellant’s Issue 1a Argument, p. 8. The Examiner’s Answer yet further argues that “Table II is an example of rules, or fields which are used to calculate rates for all the carriers. Table II includes a dimensional weight.” Examiner’s Answer Response to Appellant’s Issue 1a Argument, p. 8.

In reply to the above-outlined Table II interpretation argument by the Examiner’s Answer, it is respectfully asserted that the above-outlined argument in the Examiner’s Answer constitutes what could be described as a “common sense” argument, based not on substantial evidence found in the prior art, but rather, on the disclosure and teachings of the present application. It is respectfully asserted that an argument based on “common sense” without substantial evidence to support it would provide an insufficient basis for a determination regarding patentability. See, e.g., In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (“With respect to core factual findings in a determination of patentability ... the Board cannot simply reach conclusions based on ... its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

It is respectfully submitted that the Examiner’s Answer cites no evidence that the “DIMWT” I/O Token entry is populated by Nicholls “... in response to a first input comprising a first set of parcel specifications for a first parcel ...” as claimed, for example, by Claim 1 of the present application. Therefore, in view of the above-outlined position by the Zurko court, it is respectfully asserted that the Examiner’s Answer provides an insufficient basis for rejecting Claims 1-5, 58-59, 70 and 72 under Section 102(b).

Further, it is respectfully asserted that there is no explicit disclosure in Nicholls that a DIMWT I/O Token is populated with a value by Nicholls or that, even if it is

populated with a value by Nicholls, that such a DIMWT value is then used by Nicholls to calculate a billable weight as claimed, for example, in Claim 1 of the present application as follows:

... apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (B)(1), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight.

To support the rejection of, among others, Claim 1, the Examiner's Answer cites Column 5 at lines 34-40 of Nicholls and columns 25 and 26 at line 39 of Nicholls to support the proposition that Nicholls discloses billable weight rules and that Nicholls anticipates, for example, the above-recited billable weight determination limitations of, among others, Claim 1. Examiner's Answer Response to Appellant's Issue 1a Argument, p. 7. Specifically, at approximately line 39 of columns 25 and 26 of Nicholls, an I/O Token named "DIMRATE" is listed, and is described as "use dimensional rating;" the type description of the DIMRATE I/O Token is identified as "boolean." Nicholls, cols. 25 and 26, line 39.

It is respectfully submitted that an I/O Token data element with a data type description of Boolean would, by definition, have a value of "1" or "0." See, e.g., Wikipedia (the online "free encyclopedia"), regarding the term "Boolean data type." It is respectfully asserted that an I/O Token data element with a type description of Boolean (that by definition, would have a value of "1" or "0") regarding "use dimensional rating", even assuming for the sake of argument that such a Boolean data type element is populated by Nicholls, does not anticipate the above-recited billable weight determination limitations of Claim 1. More specifically, it is respectfully asserted that a single data element, including a single Boolean data type I/O Token, regarding "use dimensional rating" does not disclose, anticipate, teach or suggest carrier-specific billable weight rules, for *each* respective carrier of the *plurality of carriers*, as claimed by Claim 1.

Yet further, it is respectfully asserted that neither the Office Action nor the Examiner's Answer offer any explanation or evidence regarding how a single Boolean data type I/O Token could be used by all of the rate servers for all of the carriers to calculate a billable weight and/or a rate, if, as the Examiner's Answer argues, each rate server is used to calculate or determine a dimensional weight according to each carrier's rules and is also used to calculate a rate for each carrier according to each carrier's rules according to each carrier's dimensional weight calculation.

With respect to Appellant's Argument regarding both Issue 1a, and Issues 1b and 1c, the Examiner's Answer concludes that "[t]herefore with the combination of cited sections, then it is the examiner's position that Nicholls discloses calculating dimensional weight for each carrier of a plurality of carrier, in response to input of parcel specifications." Examiner's Answer Response to Appellant's Issue 1a Argument, pgs. 8-9; Examiner's Answer Response to Appellant's Issues 1b and 1c Argument, p. 10.

For the reasons given and the authorities cited above, it is respectfully asserted that the above-identified conclusions given in the Examiner's Answer regarding Appellant's Arguments regarding Issues 1a, 1b, and 1c constitute impermissible hindsight using the invention claimed in the present application as a roadmap to pick and choose disparate portions of the Nicholls reference and using what could be described as "common sense" arguments based on the disclosure and teachings of the present application, not based on any evidence in the prior art, to combine those portions to conclude anticipation of Claims 1-5, 58-59, 70 and 72. Cf., e.g., In re Mahurkar Patent Litigation, 831 F. Supp. at 1374-75, 28 U.S.P.Q.2d (BNA) at 1817; cf. also, e.g., In re Zurko, 258 F.3d at 1386, 59 U.S.P.Q.2d at 1697.

Accordingly, for the reasons given and the authorities cited above and in the Appeal Brief, it is respectfully requested that the rejection of Claims 1-5, 58-59, 70 and 72 be reversed. Further, for the reasons described above and in the Appeal Brief, it is respectfully asserted that Claims 1-5, 58-59, 70 and 72 are patentable over the references of record.

Reply Argument Regarding Issue 2 Regarding the Rejection of Claims 7, 71, 73, 78 and 83 under 35 U.S.C. §103(a) as Being Unpatentable over Nicholls in view of Kara: There is No Disclosure in Kara of Calculating a Shipping Rate for Each Delivery Service Offered by a Carrier

The Appeal Brief respectfully asserted that, as compared to the limitations of Claims 7, 71, 73, 78 and 83 (either specifically recited in those Claims, or in Claims on which those Claims ultimately depend) regarding the calculation of a shipping rate for each delivery service offered by one or more carriers, Kara discloses a system that requires that a user first pre-select a class and/or delivery “urgency”.

The Examiner's Answer responds to that argument, in part, with the statement that “[n]owhere in the claim does it state that there is no user interaction for the rates to be displayed.” Examiner's Answer Response to Appellant's Issue 2 Argument, p. 10.

It is respectfully submitted that the above-quoted statement in the Examiner's Answer is not an accurate reflection of the assertions made in the Appeal Brief and does not provide sufficient grounds on which to reject Claims 7, 71, 73, 78 and 83. Contrary to the above-quoted statement in the Examiner's Answer, the Appeal Brief did not assert that there is no user interaction for rates to be displayed. Rather, for example, independent Claim 3 (on which Claim 7 ultimately depends) specifically recites “...a first input from a first user ... comprising a first set of parcel specifications for a first parcel”

Contrary to the above-quoted statement in the Examiner's Answer, the Appeal Brief respectfully asserted that as compared to Kara which requires that a user first pre-select a class and/or delivery “urgency”, Claim 5 (on which Claim 7 depends) recites:

(D) for each respective delivery service of a plurality of delivery services offered by each respective supporting carrier, calculate a respective service-specific, carrier-specific shipping rate for shipping the first parcel.

That is, in view of the limitations of Claim 3 (on which Claim 7 ultimately depends) of “...a first input from a first user ... comprising a first set of parcel specifications for a first parcel” and as compared to limitations of Claim 5 (on which Claim 7 depends) that include calculating a shipping rate for each delivery service offered by each supporting carrier, Kara requires that a user first pre-select a class

and/or delivery "urgency", and then shows a calculated rate only for the user-pre-selected class.

It is respectfully asserted, therefore, that the combination of the references cited in the Office Action and the Examiner's Answer does not disclose, anticipate, teach or suggest each of the limitations recited by Claims 7, 71, 73, 78 and 83 (and the limitations of the Claims on which Claims 7, 71, 73, 78 and 83 depend).

The Examiner's Answer further responds that "[n]or does it claim that all rate [sic] for all services for all carriers have to be displayed at one time." Examiner's Answer Response to Appellant's Issue 2 Argument, pgs. 10-11.

It is respectfully submitted that the above-quoted statement in the Examiner's Answer is neither an accurate reflection of the limitations of Claims 7, 71, 73, 78 and 83 (and the limitations of the Claims on which Claims 7, 71, 73, 78 and 83 depend), nor does the statement, or the cited references, provide sufficient grounds for the rejection of those Claims.

First, contrary to the Examiner's Answer's response indicating that the Claims pertain to "... all rate [sic] for all services for all carriers ...," the limitations, for example, of Claim 3, recite:

(1) calculate a respective carrier-specific dimensional weight for the first parcel according to the first set of parcel specifications and according to a respective set of dimensional weight calculation rules for the respective carrier, wherein each respective carrier-specific dimensional weight is calculated according to the first set of physical dimensions of the first parcel in view of the first physical weight of the first parcel;

(2) determine whether the respective carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) for the respective carrier exceeds a corresponding respective carrier-specific dimensional weight limitation for the respective carrier; and

(3) in response to determining that the respective carrier-specific dimensional weight of the first parcel calculated in Step (B)(1) does not exceed the corresponding respective carrier-specific dimensional weight limitation for the respective carrier, designate the respective carrier as a respective supporting carrier for shipping the first parcel.

That is, according to Claim 3, only carriers for which the calculated carrier-specific dimensional weight does not exceed a corresponding respective carrier-specific dimensional weight would be designated as a respective supporting carrier.

Claim 4, which is dependent on Claim 3, recites:

(C) apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected, according to the respective set of carrier-specific billable weight rules, from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (B)(1), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight.

The Appeal Brief respectfully submitted that each of Claims 7, 71, 73, 78 and 83 (or Claims on which those Claims depend) recite limitations of an online comparison display of each shipping rate calculated for each delivery service of one or more carriers. The above-recited limitations of Claims 3-5 (on which Claim 7 depends) and the following limitations of Claim 7 are exemplary:

(E) generate an online comparison display of the respective service-specific, carrier-specific shipping rates for shipping the first parcel to a first display monitor configured with the first remote user client computer device of the particular respective user.

Further, contrary to the Examiner's Answer's response indicating that the Claims do not involve displaying the rates "... at one time," it is respectfully asserted that the Examiner's Answer's response does not consider, and does not apply a proper construction of, the claimed limitation of "generate an online comparison display"

As compared to, e.g., the above-recited limitations of Claims 3-5 and 7 (*cf. also*, e.g., limitations of Claims 71, 73, 78 and 83 and the Claims on which they depend), in order to obtain a comparison of rates using Kara, the Appeal Brief respectfully submitted that a user of Kara would need to successively indicate various urgencies to successively obtain rates for the indicated urgencies for each shipping service provider.

In response to that assertion, the Examiner's Answer responds with the statements that "Kara discloses the capability of displaying multiple rates for multiple carriers at one time, and discloses the capability of calculating rates for each service of each carrier. Therefore, the examiner considers Kara to display the rates, as claimed,

in Claims 7, 71, 73, 78 and 83.” Examiner’s Answer Response to Appellant’s Issue 2 Argument, p. 11.

It is respectfully asserted that the above-quoted conclusions stated in the Examiner’s Answer are an admission that, in fact, Kara does not disclose the limitations of Claim 7 for generating an online comparison display of the respective service-specific, carrier-specific shipping rates.

For the reasons given and the authorities cited above and in the Appeal Brief, it is respectfully asserted that the above-identified conclusions given in the Examiner’s Answer regarding Appellant’s Arguments regarding Issue 2 constitute impermissible hindsight using the invention claimed in the present application as a roadmap to pick and choose disparate portions of the Nicholls and Kara references, and to then piece them together in a way not disclosed, taught, or suggested by either reference, in an effort to conclude obviousness of the limitations of each of Claims 7, 71, 73, 78 and 83. Cf., e.g., In re Mahurkar Patent Litigation, 831 F. Supp. at 1374-75, 28 U.S.P.Q.2d (BNA) at 1817; cf. also, e.g., In re Zurko, 258 F.3d at 1386, 59 U.S.P.Q.2d at 1697.

Accordingly, for the reasons given and the authorities cited above and in the Appeal Brief, it is respectfully requested that the rejection of Claims 7, 71, 73, 78 and 83 be reversed. Further, for the reasons described above and in the Appeal Brief, it is respectfully asserted that Claims 7, 71, 73, 78 and 83 are patentable over the references of record.

Issue 3 Reply Argument Regarding the Rejection of Claims 6, and 60-61 under 35 U.S.C. §103(a) as Being Unpatentable over Nicholls in view of Barns-Slavin:
There is No Disclosure in Barns-Slavin of Calculating a Shipping Rate for Each Delivery Service Offered by a Carrier, or of Comparing a Dimensional Weight of a Particular Parcel to a Dimensional Weight Limitation for a Particular Carrier to Determine Whether the Dimensional Weight Exceeds a Carrier-Specific Dimensional Weight Limitation

The Appeal Brief respectfully asserted that determining whether a dimensional weight of a particular parcel exceeds a carrier-specific dimensional weight limitation as

claimed in Claims 3, 6, 60 and 61, is patentably distinct from determining whether a "... group of parcels met certain predetermined requirements such as, total weight of the group or average weight of the group ..." for the purpose of "... determining discounted shipping charges ..." as disclosed in Barns-Slavin.

The Examiner's Answer responds to that assertion with the argument that "... a carrier would not ship a package that it was not capable of shipping, therefore would not rate a package it was not capable of shipping. Therefore the claim limitation is rendered obvious over the prior art of record." Examiner's Answer Response to Appellant's Issue 3 Argument, p. 11.

In reply to the above-outlined capability/rating argument by the Examiner's Answer, it is respectfully asserted that the above-outlined argument constitutes what could be described as a "common sense" argument. However, it is respectfully asserted that the "common sense" argument presented in the Examiner's Answer is based on the disclosures and teaching of the present application, not on the disclosures or teachings of the prior art. It is respectfully asserted that an argument based on "common sense," without substantial evidence in the prior art to support it, would provide an insufficient basis for a determination regarding patentability. See, e.g., In re Zurko, 258 F.3d at 1386, 59 U.S.P.Q.2d at 1697 (Fed. Cir. 2001) ("With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

Accordingly, for the reasons given and the authorities cited above and in the Appeal Brief, it is respectfully requested that the rejection of Claims 6 and 60-61 be reversed. Further, for the reasons described above and in the Appeal Brief, it is respectfully asserted that Claims 6 and 60-61 are patentable over the references of record.

Issue 4a Reply Argument Regarding the Rejection of Claims 74 and 79 under 35 U.S.C. §103(a) as Being Unpatentable over Nicholls in view of Jensen: There is No Disclosure in Jensen of Calculating a Shipping Rate for Each Delivery Service Offered by a Carrier or of Comparing a Dimensional Weight of a Particular Parcel to a Dimensional Weight Limitation for a Particular Carrier

The Appeal Brief respectfully submitted that there is no disclosure in Jensen that Jensen, or the system(s) to which Jensen transmits, "... appl[ies] a respective set of carrier-specific dimensional weight calculation rules, *for each respective carrier of a plurality of carriers*, to the first set of parcel specifications to calculate a respective carrier-specific dimensional weight ..." as recited, e.g., in Claim 1 (emphasis added) on which Claim 74 depends.

Further, the Appeal Brief respectfully submitted that there is no disclosure in Jensen that Jensen, or the system(s) to which Jensen transmits, "...calculate[s], *for each respective carrier of a plurality of carriers*, a respective carrier-specific dimensional weight of the first parcel ..." as recited in Claim 2 on which Claim 79 depends (emphasis added).

The Examiner's Answer responds by stating that "Jensen is not used to show this limitation. Jensen is merely used to show the comparison of dimensional weight and actual weight and taking the largest weight to calculate rates." Examiner's Answer Response to Appellant's Issue 4a Argument, p. 12.

It is respectfully asserted that neither the above-quoted statement from the Examiner's Answer, nor the combination of references cited, completely reflects each of the limitations of Claims 74 and 79 (including the limitations of the Claims on which Claims 74 and 79 depend). It is therefore respectfully asserted that the cited references provide insufficient grounds on which to base the rejection of those Claims. *Cf., e.g., M.P.E.P.* §§ 2142 ("To establish a *prima facie* case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations.") and 2143 ("To establish a *prima facie* case of obviousness, ... the prior art

reference (or references when combined) must teach or suggest all of the claim limitations.”).

As compared to the above-quoted statement in the Examiner's Answer, it is respectfully submitted that neither Claim 74, nor Claim 1 on which Claim 74 depends, recites merely comparing dimensional weight to actual weight and taking the largest weight to calculate rates. Rather Claim 1 on which Claim 74 depends, recites:

(2) apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (B)(1), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight.

Further, as compared to the above-quoted statement in the Examiner's Answer, it is respectfully submitted that neither Claim 79, nor Claim 2 on which Claim 79 depends, recites merely comparing dimensional weight to actual weight and taking the largest weight to calculate rates. Rather Claim 2 on which Claim 79 depends, recites:

(C) in response to the request by the first user to ship the first parcel:

(1) identify each respective carrier of the plurality of carriers that would support shipping the first parcel according to the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in Step (B), and according to a respective carrier-specific dimensional weight limitation for the respective carrier; and

(2) apply a respective set of carrier-specific billable weight rules, for each respective carrier of the plurality of carriers, to the first set of parcel specifications to determine a respective carrier-specific billable weight of the first parcel for the respective carrier, wherein the respective carrier-specific billable weight of the first parcel for the respective carrier is selected from a group consisting of: the physical weight of the first parcel, the respective carrier-specific dimensional weight of the first parcel for the respective carrier calculated in step (B), a respective carrier-specific oversize weight of the first parcel, and a respective carrier-specific letter weight.

Accordingly, for the reasons given and the authorities cited above and in the Appeal Brief, it is respectfully requested that the rejection of Claims 74 and 79 be reversed. Further, for the reasons described above and in the Appeal Brief, it is

respectfully asserted that Claims 74 and 79 are patentable over the references of record.

**Issue 4b Reply Argument Regarding the Rejection of Claims 62 and 66
Under 35 U.S.C. §103(a) as Being Unpatentable Over Nicholls in View of
Jensen**

Because Claims 62 and 66 ultimately depend on independent Claim 58, for the reasons given above with respect to independent Claim 58 why Claim 58 is patentable over Nicholls, it is respectfully submitted that Claims 62 and 66 are therefore also patentable over Nicholls.

Further, because Claim 66 depends on Claim 59, for the reasons given above with respect to Claim 59 why Claim 59 is patentable over Nicholls, it is respectfully submitted that Claim 66 is therefore also patentable over Nicholls.

For the reasons given and authorities cited above and in the Appeal Brief regarding independent Claim 58 (on which Claims 62 and 66 ultimately depend) and regarding Claim 59 (on which Claim 66 depends), it is respectfully requested that the rejections of Claims 62 and 66 be reversed. Further, for the reasons described above and in the Appeal Brief, it is respectfully asserted that Claims 62 and 66 are patentable over the references of record.

REPLY ARGUMENT CONCLUSION

Accordingly, for the above-given reasons and authorities, and for the reasons given and authorities cited in the Appeal Brief, it is respectfully requested that the rejections of Claims 1-7, 58-62, 66, 70-74, 78-79, and 83 be reversed. Further, for the reasons and authorities described above, and for the reasons given and authorities cited in the Appeal Brief, it is respectfully asserted that Claims 1-7, 58-62, 66, 70-74, 78-

79, and 83 are patentable over the references of record and that the application is in condition for allowance.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By Marilyn R. Khorsandi Feb. 7, 2007
Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856